

Appl. No. 10/612,839
Amtd. Dated 6/24/2004
Reply to Office Action dated 5/28/2004

REMARKS

The examiner has required election of species including species 1 e.g. sets of claims 3-10, 58, and 49-57; species 2 e.g. sets of claims 11-19; species 3 e.g. sets of claims 43, 39-42, 44, 45-46, and 48; species 4 e.g. sets of claims 29-34; 36-37, and 62; and species 5 e.g. sets of claims 21-24, 27-28, 59, 60, 25-26, and 61.

Applicant submits that the election/restriction in the present application is improper for at least the following compelling reasons and accordingly traverses the election/restriction.

Applicant first submits that the election is improper pursuant to MPEP 806.04(e) which provides that *claims are definitions of inventions and claims are never species*. *To the contrary, species are always specifically different embodiments*. Despite the language of MPEP §806, the Office improperly sets forth the alleged grouping of species based upon the sets of claims. Applicant requests withdrawal of the election requirement or identification of the alleged different embodiments in accordance with the MPEP.

Applicant also refers the Office to MPEP §811 stating that a requirement for election will be made before any action on the merits. Section 811 also states that a requirement should be made as early as possible in the prosecution (i.e., in the first action if possible), otherwise as soon as the need for a proper requirement develops. Applicant notes that the claims of the pending

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application correspond to the claims which were examined and finally rejected in the parent application. Accordingly, no additional need for a proper requirement has developed since the claims were examined during the prosecution of the parent application and the current requirement is improper.

Further with respect to section 811, *it is stated that before making a requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.* In no fair interpretation may the re-examination of the pending already examined claims be considered to be a serious burden as required. The claims have already been considered by the Office, searched and finally rejected over the prior art. There is absolutely no serious burden to the Office in consideration of the already-examined and previously rejected claimed subject matter.

MPEP §808.01(a) provides that election of species should be required *prior to a search on the merits* in all applications containing claims to a plurality of species with no generic claims. As mentioned above, the proper time for issuing the election has passed inasmuch as the claimed subject matter has already been searched and examined in the parent application.

Applicant further contends that any restriction is improper for at least the following reasons. First, the Office has apparently already searched the pending claims which are now the subject of restriction. Accordingly, now requiring elimination of any set of claims will not reduce the scope of searching, and thus

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there are no efficiencies gained by imposing the election, let alone the requirement of a serious burden pursuant to the MPEP.

Second, this application is a continuation with the same independent claims as examined in the parent application. The collective subject matter has therefore already been searched in the parent application. Accordingly, there are no searching efficiencies gained by invoking election now at this overly late date. Election at this late time is not timely, and does not have any sense of fairness to Applicant.

Third, there is increased burden on the U.S. Patent and Trademark Office, on the Applicant and ultimately on the public in prosecuting multiple separate patent applications. For Applicant, splitting the invention into multiple cases increases costs associated with government fees, prosecution fees, and maintenance fees for multiple patents. For the PTO, there are increased costs associated with conducting multiple searches in multiple applications and multiple examinations for an invention that already has been searched and examined. It further ultimately produces a burden on the pertinent public that will review Applicant's commonly patented technology. Such people will be compelled to unnecessarily review multiple issued patents and file histories.

For at least these reasons, Applicant respectfully asserts that the Examiner's election/restriction is improper, and requests that the Examiner withdraw the election/restriction requirement and consider the *already examined*

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and rejected claims in this application at this time. In the event the election/restriction is not withdrawn, Applicant provisionally elects, with traverse, species I including claims 3-10 and 49-58 for prosecution on the merits.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated:

6/24/04

By:



James D. Shaurette
Reg. No. 39,833